

Rejections Under 35 U.S.C. § 103

Claims 1-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Frank (EP Patent No. 1 596 594) in view of Redford (U.S. Patent No. 5,392,095).

Applicant respectfully traverses the rejection of claims 1-18 because a *prima facie* case of obviousness has not been established. A *prima facie* case of obviousness requires a teaching or suggestion of all the claim limitations, some suggestion or motivation to modify the reference or to combine reference teachings, and some reasonable expectation of success. *M.P.E.P.* § 2143.

Applicant submits that the combination of Frank and Redford fails to teach all elements of the claimed subject matter. For example, Applicant submits that neither Frank, nor Redford, either individually or in combination, provides a pointing device as recited in claims 1, 8, 12 and 16. In particular, Applicant submits that neither Frank, nor Redford, either individually or in combination, provides a pointing device operable without regard to orientation, as recited in claim 1, 8, 12 or 16. Consequently, Applicant submits that the combination of Frank and Redford fails to teach or suggest all elements of the claimed subject matter.

In addition, Applicant submits that no motivation exists to pursue the proposed combination of Frank and Redford. The Office Action states:

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to integrate a control device such that the control device may operate both as a cursor control device and a remote control device as taught by Frank and Redford. (*Page 3*).

Applicant respectfully submits that the Office Action has not identified a motivation to combine Frank with Redford. The mere possibility of combining teachings fails to provide the requisite motivation to actually combine references. In other words, the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. *M.P.E.P.* § 2143.01.

In fact, Applicant submits that Frank and Redford teach away from combining with each other, and therefore the proposed combination fails to support a *prima facie* case of obviousness. Frank states:

To control the target device, the user holds the control device such that the bottom of the device is pointed at the target device. Upon depressing a switch on the control device, the control device transmits the modulated signal to the target device. (*Column 4, lines 8-13*).

On the other hand, Redford states:

AMENDMENT AND RESPONSE

Serial Number: 08/904,056

Filing Date: July 31, 1997

Title: AUDIO AND VIDEO CONTROLS ON A POINTING DEVICE FOR A COMPUTER

Page 4

Dkt: 450.156US1

In operation, as the remote is tilted left, right, up or down, this angular motion is sensed and appropriate signals transmitted to the computer via the base unit, causing corresponding movement of a cursor on the screen. (*Column 3, lines 58-62*).

Applicant submits that manipulating a device to control cursor movement (as in Redford) is inconsistent with, and will frustrate the objective of, "aiming" the device at the target (as in Frank). Consequently, it appears that a user would first need to decide to either manipulate a cursor or aim at a target device. The proposed combination seems to require an awkward hand movement while keeping an eye on the cursor and the target device. Applicant therefore, respectfully submits that the proposed modification renders the prior art unsatisfactory for its intended purpose, in conflict with the precept of M.P.E.P. § 2143.01. For these and other reasons, Applicant submits that the cited documents teaches away from the proposed combination.

As to dependent claims 2-7, 9-11, 13-15 and 17-18, Applicant respectfully submits that each is patentable as a further limitation of independent base claims 1, 8, 12 and 16, respectfully, and the discussion for which is repeated herein.

Reconsideration and allowance of claim 1-18 is respectfully requested.

AMENDMENT AND RESPONSE

Serial Number: 08/904,056

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Title: AUDIO AND VIDEO CONTROLS ON A POINTING DEVICE FOR A COMPUTER

Page 5

Dkt: 450.156US1

CONCLUSION

Applicants believe the claims are in condition for allowance and requests reconsideration of the application and allowance of the claims. The Examiner is invited to telephone the below-signed attorney at 612-373-6911 to discuss any questions which may remain with respect to the present application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Assistant Commissioner of Patents, Washington, D.C. 20231 on July 26, 2000.

Name CANDY BUEHLING

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